Remarks and Arguments

Claims 38 and 68 have been amended to more particularly point out the invention. Support for the amendment is found on pages 10-11 of the specification. Claim 54 has been canceled herein.

Claims 1, 2, 4-34, 36-39, 45-51 and 53-68 are pending. The pending claims stand rejected. Each of the rejections is addressed below.

35 U.S.C. § 102

The standard for anticipation under 35 U.S.C. § 102 requires that each and every element as set forth in the claim be found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The Office has not met this standard with respect to any of the pending claim rejections.

U.S. Patent No. 6,776,791

Claims 1, 2, 5, 6, 12-15, 18-21, 23, 26-29, 31, 34, 36, 38, 45-51, 53-68 stand rejected in light of U.S. Patent No. 6,776, 791 to Stallings (hereinafter "Stallings"). The Office alleges that Stallings discloses a catheter having an elongated member, a stent, a sheath, a male interlock, a female interlock and a cell defined region. The Office further alleges that Stallings discloses a stent with a diameter of about 20 mm. Because the diameter of the stent is about 20 mm, the Office concludes that Stallings, therefore, discloses at least a portion of each first and second interlock structures being positioned at a distance at most of 5 mm from the cell defining region. Applicants respectfully submit that the Office is mistaken in these allegations and therefore traverse the rejection.

The lynchpin of the Office's argument with respect to claims 1, 2, 5, 6, 12-15, 18-21, 23, 26-29, 31, 34, 36, 38, 45-49, 53, 62, 66, 67, and 68 concerns the disclosure in Stallings regarding stents with a diameter of less than 20 mm (column 4, lines 32-39). Examples of these stents are depicted in Figures 5-8. Indeed, the Office has attached

Figure 6, along with several other figures from Stallings, to the Office Action dated November 17, 2004. Handwritten comments, by the Examiner, are provided on several of the attached figures, including Figure 6. On Figure 6 the Office suggests that because the diameter of the stent is 20 mm that a portion of each first and second interlock structures is positioned at a distance at most of 5 mm from the cell defining region. Applicants submit that this conclusion is mere speculation because no other dimensions, other than the stent diameter are disclosed in Stallings, either in the specification or the figures relied upon by the Office. At best it may be possible to conclude from Stallings that the distance depicted by the Examiner in the comments written on Figure 6 is less than 20 mm, however, there is nothing in Stallings to suggest it is at most 5 mm from the cell defining region, as recited in claims 1, 21, 29, 36, 38, 45, 62, 66, 67, and 68. Claims 2, 5, 6, 12-15, 18-20, 23, 26-28, 31, 34, 36, 45-49, 63-65 all depend from one of claims 1, 21, 29, 36, 38, 45, 62, 66, 67, and 68. Because Stallings does not disclose each and every element, either expressly or inherently, as set forth in the claims 1, 21, 29, 36, 38, and 45 or their respective dependencies it cannot anticipate these claims.

More importantly, Applicants believe the Office has misunderstood the term "cell defining region." Based on the handwritten comments provided by the Examiner on Figure 12 from Stallings, Applicants believe that the Office is under the impression that cell defining region refers to the entire length of the stent. This is not the case. The specification states on page 11, first paragraph (beginning with "Referring to Fig. 6A") "the stent 12 includes a lumen reinforcing structure including a plurality of struts 13 adapted to define open cells 15 (best shown in Fig. 2B) when the strut is deployed," (emphasis added). The cell defining region, as depicted in Fig. 2B, and described on page 11 refers to the plurality of openings defined by the struts. Nothing in Stallings teaches expressly or inherently at least a portion of each first and second interlock structures positioned at a distance at most of 5 mm from the cell defining region, as cell defining region is described in the specification. Accordingly, Stallings does not anticipate independent claims 1, 21, 29, 36, 38, 45, 62, 66, 67, and 68, or dependent claims 2, 5, 6, 12-15, 18-20, 23, 26-28, 31, 34, 36, 45-49, 63-65. Applicants respectfully request withdrawal of the rejection.

Claim 50 recites "one or more first interlock structures each having a rounded enlargement, the rounded enlargement of the one or more first interlock structures defining an opening." Claim 51 depends on claim 50. Claim 55 recites a similar limitation. Claim 56 depends on claim 55. Stallings does not expressly or inherently teach this limitation; therefore Stallings cannot anticipate these claims. Applicants respectfully request withdrawal of the rejection.

Claim 57 recites "a cell defining region located between the first and second ends, the cell defining region defining cells each having a cell length, the stent also including at least one or more first interlock structures positioned a distance from the cell defining region of the implant, the distance being at most equivalent to the cell length of the cells." Claims 58-61 depend on claim 57. Stallings does expressly or inherently teach interlock structures that are a distance that is at most equivalent to the cell length of the cells, as recited in claim 57. Accordingly it cannot anticipate claims 57-61. Applicants respectfully request withdrawal of the rejection.

Claim 54 has been canceled herein thus obviating the rejection with respect to this claim.

U.S. Patent No. 6,077,297

Claims 1, 2, 5, 6, 12-15, 18, 36, 38, 45, 62 and 66 stand rejected under 35 U.S.C. §102 in light of U.S. Patent No. 6,077,297 (hereinafter "Robinson"). The Office alleges that Robinson discloses a catheter having an elongated member, a stent, a sheath, a male interlock, a female interlock, a cell defined region, at least a portion of each first and second interlock structures being positioned a distance at most 5 mm from the cell defining region. Applicants note that the comments provided above regarding the term "cell defining region" apply to Robinson, as well. Moreover, Applicants have found nothing, and the Office has pointed to nothing in Robinson that discloses, expressly or inherently, at least a portion of each first and second interlock structures positioned at a distance at most of 5 mm from the cell defining region, as cell defining region is described in the specification. Applicants respectfully request that the Office point out specifically where Robinson discloses this, or alternatively withdraw the rejection.

U.S. Patent No. 6,267,783

Claim 68 stands rejected under 35 U.S.C. §102 in light of U.S. Patent No. 6,267,783 (hereinafter "Letendre"). The Office alleges that Letendre discloses a catheter having an elongated member, a stent, a sheath, a male interlock, a female interlock, a cell defined region, and at least a portion of the first interlock structure being positioned a distance at most 5 mm from the cell defining region. Claim 68 has been amended herein to recite "wherein the portion of the first interlock structure that is at most 5 mm from the cell defining region is the free terminal end of the first interlock structure." Applicants submit that Letendre does not disclose, expressly or inherently, each and every element of claim 68, as amended herein, and therefore does not anticipate the claim. Accordingly, Applicants respectfully request withdrawal of the rejection.

35 U.S.C. § 103

Claims 4, 22, and 30 as well as 16, 17, 24, 25, 32, 33, 37 and 39 all stand rejected as being allegedly obvious in light of Stallings. Each of these rejections is addressed below.

The Prima Facie Case Requirement

The Patent and Trademark Office (PTO) bears the burden of initially establishing a prima facie case of obviousness. MPEP § 2142. MPEP § 2143 provides the standard required to establish a prima facie case of obviousness. "First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one or ordinary skill in the art, to modify the reference or to combine what the reference teaches. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim limitations."

The motivation to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not the applicant's disclosure. *In re Vaeck,* 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The references must be considered as a whole and must suggest the desireability, and thus the obviousness of making the combination. *Hodosh v. Block Drug Col, Inc.,* 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986); MPEP § 2141.

The Prima Facie Case Requirement Has Not Been Satisfied

The PTO has not met its burden in the instant case. The Office alleges that claims 4, 22, and 30 are obvious and therefore unpatentable in light of Stallings. The Office alleges that Stallings discloses the invention as substantially claimed, but admits that Stallings does not disclose a radio opaque marker positioned adjacent to the implant mounting region. The Office, nonetheless, alleges that modifying Stallings to provide a plurality of radio opaque markers positioned adjacent to the implant mounting would have been an obvious design choice. Applicants disagree and thus, traverse the rejection.

Applicants believe the premise that Stallings discloses the invention as substantially claimed is incorrect. As discussed above, Stallings does not disclose at least a portion of each first and second interlock structures positioned at a distance at most of 5 mm from the cell defining region, as cell defining region is described in the specification. Thus, Stallings does not teach or suggest all the claim limitations as required. Claims 4, 22, and 30, therefore, are not prima facie obvious in light of Stallings. Moreover, the Office has not pointed to any reference to support its position that the placement of the radio opaque markers was merely a design choice. If the Office is relying on personal knowledge in making this rejection Applicants request that the Examiner submit an affidavit in compliance with 37 CFR § 1.104(d)(2). Applicants respectfully request withdrawal of the rejection.

The Office further alleges claims 16, 17, 24, 25, 32, 33, 37 and 39 are obvious and therefore unpatentable in light of Stallings. The Office alleges that Stallings discloses the invention as substantially claimed, but admits that Stallings does not disclose a portion having a distance at most 1 millimeter from the cell defining region of the implant. The Office alleges that at the time the invention was made, it would have been an obvious design choice for the skilled artisan to modify the length of the interlock structures such that the length was at most 1mm because the Applicant has not disclosed the 1mm distance provides an advantage or solves a problem. The Office goes on to allege that the skilled artisan would have expected Applicant's invention

would perform equally well with the above 5 mm distance. Applicants respectfully disagree.

The Office seems to suggest that because Stallings allegedly discloses a 5mm distance that 1 mm distance would be a mere obvious design choice. The argument presented by the Office, however, fails because it is based upon the erroneous premise that Stallings discloses at least a portion of each first and second interlock structures positioned at a distance at most of 5 mm from the cell defining region, as cell defining region is described in the specification. But as discussed above Stallings does not disclose this. Thus, Stallings does not teach or suggest all the claim limitations as required and claims 16, 17, 24, 25, 32, 33, 37 and 39 are not prima facie obvious in light of Stallings. Here again, the Office has not substantiated its position regarding the alleged obviousness of the claim subject matter. If the Office is relying on personal information to support its position that the 1 mm distance would be a mere obvious design choice Applicants request that the Examiner submit an affidavit in compliance with 37 CFR § 1.104(d)(2). Applicants respectfully request withdrawal of the rejection.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account.

Respectfully submitted

E Stewart Mittler Date: 4/18/05

E. Stewart Mittler, Esq., Reg. No. 50,316
KUDIRKA & JOBSE, LLP
Customer Number 021127
Tel: (617) 367-4600 Fax: (617) 367-4656